

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 21

**UNITED STATES PATENT AND TRADEMARK OFFICE**

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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

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Ex parte KEIJI MORIYAMA and KAZUNARI YOSHIDA

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Appeal No. 2003-0560  
Application No. 09/472,893

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HEARD: JULY 16, 2003

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Before ABRAMS, STAAB and BAHR, Administrative Patent Judges.  
BAHR, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1, 7 and 8. Claims 5 and 6, the only other claims pending in this application, stand objected to as depending from a rejected claim.

### BACKGROUND

The appellants' invention relates to a four-piece solid golf ball having high launch angle (specification, page 1). A copy of the claims under appeal is set forth in the appendix to the appellants' brief. As is evident from the claims, a key feature of appellants' invention is the hardnesses of the four components (core, intermediate layer, outer layer and cover) of the golf ball.

The examiner relied upon the following prior art reference of record in rejecting the appealed claims:

Higuchi et al. (Higuchi)	5,733,205	Mar. 31, 1998
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The following rejection is before us for review.

Claims 1, 7 and 8 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Higuchi.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellants regarding the above-noted rejection, we make reference to the answer (Paper No. 16) for the examiner's complete reasoning in support of the rejection and to the brief (Paper No. 15) for the appellants' arguments thereagainst.

### OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellants' specification and claims, to the applied prior art reference, and to the

respective positions articulated by the appellants and the examiner. As a consequence of our review, we make the determinations which follow.

Higuchi, the reference relied upon by the examiner in rejecting the claims, discloses a multi-piece solid golf ball comprising a core 3 having a hardness of 47-65 Shore D (72-96 JIS-C), a surrounding layer 4 having a hardness of 15-70 Shore D (30-103 JIS-C) formed on the core, an inner cover 6 having a hardness of up to 57 Shore D (up to 86 JIS-C) formed on the surrounding layer and an outer cover 7 having a hardness of 58-80 Shore D (87-116 JIS-C) covering the inner cover. According to Higuchi (column 2, line 66 et seq.),

[t]he inner cover layer 6 preferably has a Shore D hardness of up to 57 degrees, more preferably 35 to 56 degrees. If the inner cover layer hardness exceeds 57 degrees, the ball would offer a rather hard feel.

The examiner recognizes that the hardness of Higuchi's inner cover, which corresponds to the outer layer recited in appellants' claim 1, has a hardness (up to 86 JIS-C) less than the range of 88 to 100 JIS-C of the outer layer called for in appellants' claim 1 but dismisses it as not being a "true" difference between the claimed invention and Higuchi's golf ball (answer, page 6). According to the examiner (answer, page 5),

the disclosure of Higuchi et al. clearly encompasses the hardness ranges encompassed by the claims and it would have been obvious to one having ordinary skill in the art at the time the invention was made to optimize the hardnesses of Higuchi et al. to include these specific ranges to improve the feel of the golf ball.

Appellants (brief, pages 7 and 8) argue that claims 1, 7 and 8 are patentable over Higuchi because Higuchi fails to disclose the intermediate layer hardness range of 88 to 100 JIS-C called for in appellants' claims and, further, that Higuchi teaches away<sup>1</sup> from the claimed range. We find this argument persuasive with regard to claim 1, as well as claim 7 which depends therefrom. Specifically, in light of Higuchi's teaching that "[i]f the inner cover layer hardness exceeds 57 degrees [86 JIS-C], the ball would offer a rather hard feel," (Higuchi, column 3, lines 1-3) we agree with appellants that one of ordinary skill in the art would not have been led to modify the inner layer to have a hardness exceeding 86 JIS-C. It thus follows that we shall not sustain the examiner's rejection of claim 1 or claim 7 which depends from claim 1.

We do not, however, find this argument persuasive with regard to claim 8, because claim 8 does not recite that the hardness of the intermediate layer is 88 to 100 JIS-C. In that this is the only argument offered in appellants' brief as to the patentability of claim 8, we shall summarily sustain the examiner's rejection of claim 8.

### CONCLUSION

To summarize, the decision of the examiner to reject claims 1, 7 and 8 under 35 U.S.C. § 103 is affirmed as to claim 8 and reversed as to claims 1 and 7.

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<sup>1</sup> Our reviewing court in *In re Gurley*, 27 F.3d 551, 553, 31 USPQ2d 1130, 1131 (Fed. Cir. 1994) stated that "[a] reference may be said to teach away when a person of ordinary skill, upon [examining] the reference, would be discouraged from following the path set out in the reference, or would be led in a direction divergent from the path that was taken by the applicant."

No time period for taking any subsequent action in connection with this appeal  
may be extended under 37 CFR § 1.136(a).

AFFIRMED-IN-PART

NEAL E. ABRAMS	)	
Administrative Patent Judge	)	
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	)	BOARD OF PATENT
LAWRENCE J. STAAB	)	APPEALS
Administrative Patent Judge	)	AND
	)	INTERFERENCES
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JENNIFER D. BAHR	)	
Administrative Patent Judge	)	

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